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REMARKS

Claims 1 - 21 are pending in the present application. Applicants request reconsideration and allowance of the claims. Claims 1, 13 and 18 are amended to improve the punctuation or grammar of the claim and not for patentability or to narrow the scope of the claims.

Rejection of Claims 1 - 6, 9, 11 - 14 and 16 - 20 Under Section 102

The Examiner rejects claims 1 - 6, 9, 11 - 14 and 16 - 20 under Section 102 in view of U.S. Patent No. 5,815,561 to Nguyen et al. ("Nguyen et al."). Applicants traverse this rejection and submit that Nguyen et al. do not teach each limitation of the claims.

Claim 1 recites a message for communication among network elements. The message comprises at least one media identifier including a first section and a second section. The first section identifies one of a stored media file retrieved by a network element and the second section identifies a media file type of the stored media file when the first section identifies the stored media file. Applicants submit that the portions of Nguyen et al. cited by the Examiner do not correspond to these claim limitations.

The Examiner asserts that Nguyen et al. teach a message for communication among network elements wherein the message comprises at least one media identifier including a first section and a second section, citing col. 18, lines 20-25. This portion of Nguyen et al. teaches about the Advanced Intelligent Network (AIN) message protocol. The AIN network communicates messages between components of a portion of the PSTN of a local exchange carrier. See col. 10, lines 1 - 10 and FIG. 1, feature 11. The AIN message protocol establishes a syntax for a standardized set of messages that are exchanged amongst the components of the AIN. Col. 8, lines 20 - 25 explain that an AIN message includes a designation of a message type, such as a query message, conversation message and response message. Nguyen et al. do not mention in this portion of Col. 8 that the message includes a media identifier including a first section and second section. Two features of this claim

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limitation are not taught at col. 8, lines 20 -25. First, they do not teach a "media" identifier. The message "types" taught in Nguyen et al. are only disclosed as text messages with different meanings. Indeed, since an AIN message is transmitted between network components within the AIN, Applicants submit that there would be no suggestion or need for a "media" message in the internal communications of the PSTN. Second, Nguyen et al. do not teach a message having a first second and second section of a media identifier. Nguyen et al. only teach one section in that it only mentions the definition of certain message categories.

Next, the Examiner equates the remaining portion of claim 1 with col. 18, lines 30 - 41. Claim 1 further requires that the first section identifies a stored media file retrieved by a network element and an action to be performed by the network element, and the second section identifies a media file type of the stored media file. Nguyen et al. in this portion does not teach these limitations. They do teach that there are several possible AIN messages, such as Info_Analyzed message and Termination_Notification message. When a network element receives a message, the element relies on the message type definition and the specific message definition to interpret the message and respond.

Importantly, Applicants note that Nguyen et al., and the AIN protocol, do not teach several limitations in this last portion of claim 1. Specifically, col. 8, lines 30 - 41 do not mention a message that identifies a stored media file that is to be retrieved by a network element. Nguyen et al.'s disclosure teaches a message that is self-contained, i.e., where the message includes a reference to a message type and the message itself identifies what response should be performed by the network element. In contrast, claim 1 requires the message's first section to refer to another separately stored media file that is to be retrieved by a network element. No such separation of the message and the stored media file is present in Nguyen et al. Further, since the AIN protocol does not reference in its message a stored media file, the AIN protocol further does not teach the second section of the message that identifies a media file type of the stored media file, as required by claim 1.

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Further distinguishing features between the AIN protocol and the present invention may be found in the Introduction section in the present specification.

Therefore, Applicants submit that claim 1 is patentable and in condition for allowance.

Claims 2 - 6 depend from claim 1 and recite further limitations therefrom. Claims 9 and 11 - 12 also depend from claim 1.

Claim 13 recites a system available to provide a multimedia service. The limitations in claim 13 are similar to those set forth in claim 1. Therefore, for the same reasons set forth above, Applicants submit that claim 13 is patentable over Nguyen et al. Claims 14 and 16 - 18 depend from claim 13 and recite further limitations therefrom. Accordingly, Applicants submit that these claims are patentable as well.

Claim 19 recites a method of processing a message for communicating between network elements, the message that is processed has a format including a plurality of media identifiers, each media identifier identifying one of a media file and an action item. This claim also includes a first media identifier and a second media identifier. The first media identifier includes a menu offset. This limitation is not taught in Nguyen et al. The other limitations of claim 19 are also not taught by Nguyen et al. as set forth above in the arguments relative to claim 1.

Claim 20 depends from claim 19 and recites further limitations therefrom. Applicants submit that claim 20 is patentable as well.

Rejection of Claims 7, 8 and 21 Under Section 103

The Examiner rejects claims 7, 8 and 21 under Section 103 in view of Nguyen et al. in view of U.S. Patent No. 5,438,568 to Weisser ("Weisser"). Applicants submit that these claims are not obvious in view of Nguyen et al. and Weisser.

The Examiner asserts that Weisser teaches the limitation of claim 7 related to the second section includes a third group of bits that identify a menu offset used to determine the

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next announcement to play to a caller. Applicants submit that Weisser does not teach this limitation. The Examiner cites col. 7, lines 9 - 25 of Weisser, which teaches a different process; namely, where a called party has signed up for a voice announcement service. When a caller calls a called party, the process involves detecting whether the called party has subscribed to the voice announcement service where the calling party's identification is announced to the called party. If the called party is a subscriber, then a voice announcement is provided to identify the incoming call.

In contrast to claim 7, there is no mention in Weisser regarding a "menu offset" within a third group of bits of a message. There is further no mention of a menu offset used to determine a next announcement to play to a caller. In Weisser, each voice announcement to the subscribing called party comes as a result of being called. There is no mentioned of an announcement and then a menu offset being used to determine a "next" announcement. Under Weisser, a "next" announcement would be presented upon another person dialing a call to a subscriber called party. Therefore, the next announcement has nothing to do with a menu offset in the message.

Therefore, Applicants submit that claim 7 is patentable over the combination of references.

Further, the Examiner rejected claim 21 for the same reasons as claim 7. However, claim 21 requires the first media identifier to identify an announcement prompting the user to select one of a plurality of the menu items and further comprising a step of playing the announcement to the user after decoding the first media identifier. Weisser does not teach providing an announcement prompting the user to select one of a plurality of menu items and then playing the announcement to the user. As mentioned above, this portion of Weisser teaches a caller identifying subscriber system where subscribers have the caller's id announced to them. There is no mention in this portion of Weisser of prompting the user to

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select one of a plurality of menu items. Therefore, Applicants submit that claim 21 is patentable over the combination of references.

The Examiner rejects claim 8 arguing that col. 7, lines 44 - 54 of Weisser teaches the limitation of including a plurality of media identifiers and the menu offset is used to identify one of the plurality of media identifiers. This portion of Weisser teaches a synthesizer that announces the identity of a calling party and the called party can enter a number on the phone to indicate whether or not they wish to receive the call. Applicants submit that this is not the same limitation as that taught in claim 8. First, there is no mention of a menu offset in this portion of Weisser. Next, the claim requires the menu offset to be used to identify one of a plurality of media identifiers. This is not taught by Weisser wherein he simply notes that once a synthesized voice announces the identity of the calling party, the called party can press a number on the phone and accept or reject the call. This process does not include the same limitations as are recited in claim 8.

Therefore, Applicants submit that claim 8 is patentable over the combination of references and in condition for allowance.

Rejection of Claims 10 and 15 Under Section 103

The Examiner rejected claims 10 and 15 under Section 103 in view of Nguyen et al. and U.S. Patent No. 5,519,640 to Ganesan ("Ganesan"). Applicants traverse this rejection.

Claim 10 depends from claim 1 and further recites the media file including one of video, fax, music, data and an announcement. Claim 15 depends from claim 13. The Examiner states that it would be obvious to combine Ganesan with Nguyen et al. because the motivation would be to have different types of media traverse over the network. Applicants submit that there is no motivation to combine these references.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the

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references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purposes, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, if the proposed modification of the prior art would change the principle operation of the prior art invention being modified, then the teaching of the reference is not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The principles outlined in both these cases are applicable here.

Ganesan has a purpose of providing a multimedia codec for a frame relay network. Different types of media may be transmitted from different site equipment and converted to a standard packet for transmission over the frame relay network. See Abstract. The reason that there would be no motivation to combine these references is that Nguyen et al. focuses on the AIN protocol, which is a messaging protocol for exchanging messages between network elements within a PSTN. Feature 11 shown in FIG. 1 is the AIN portion of the PSTN. There is no connection to "site equipment" or a computer viewed by a person. In other words, these AIN messages are all internal messages regarding how the PSTN is to process calls. As mentioned above, these are text messages, not "media" messages since there is no person to view or listen to a "media" message. There is simply no need to blend a multimedia codec or video, fax, music or other multimedia message types as disclosed from Ganesan into the

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subject matter of Nguyen et al. In order to perform such a blending, the fundamental purpose of Nguyen et al., namely, to exchange messages between network elements of a PSTN, would have to be changed wherein the messages would have to be delivered or meant for end-users that could see or hear a media message.

Therefore, Applicants submit that there is simply no reason or suggestion to combine Nguyen et al. with Gancsan. For this reason, Applicants further submit that claims 10 and 15 are patentable since these references cannot be legally combined.

CONCLUSION

Having addressed the rejection of claims 1 - 21, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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